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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,785	08/03/2001	Thomas Lopatic	14616	7412

7590 05/06/2005

Scully, Scott, Murphy & Presser
400 Garden City Plaza
Garden City, NY 11530

EXAMINER

BAYAT, BRADLEY B

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/921,785

Applicant(s)

LOPATIC, THOMAS

Examiner

Bradley B. Bayat

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☒ Claim(s) 9-17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restriction

Applicant's election without traverse of Group I: Claims 1-17 in the reply filed on 27 December 2004 is acknowledged.

Status of Claims

Applicant amended claims 4, 5 and 8-17 and withdrew claims 18-75 in the above referenced response. Thus, claims 1-17 are presented for examination on the merits.

Claim Objections

Claims 9-17 are objected to because of the following informalities: Although the applicant preliminarily corrected the improper multiple dependencies of claims 9-17, the language "according to one of the claims..." was not properly amended to reflect the correction.

Furthermore,

In light of the preliminary amendment, applicant is informed that claim 3 and 7 remain dependent on claims 1 or 2 and 5 or 6, respectively.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 5 recites the limitation "said modifying" as part of step (d). There is insufficient antecedent basis for this limitation in the claim. Moreover, the further characterization of this step is unclear and confusing since applicant recites "...information extracted from at least part of data of one or more initial and/or intermediate and/or final states of the creation process." Applicant's limitation refers to either a beginning, middle and/or end state of the creation of a software product. It is unclear whether the applicant is referring to execution of code at those times, whether there is a temporal connection as to execution of software, and whether "creation" is in actuality referring to initial development of the software, creation of the license to use the software or modification of each phase during execution of the software license. Applicant must particularly point out and distinctly claim the subject matter which applicant regards as the invention. Due to their dependency on claim 5, claims 6-17 are also rejected under 35 U.S.C. 112, second paragraph.

Furthermore, the preamble of independent claim 5 recites "a method for software license management and online software license enforcement," wherein the preamble of dependent claims 6-17 recite "a method of modifying one or more files of a software product." This inconsistency renders the claims indefinite as failing to distinctly claim the subject matter applicant regards as the invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

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international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Fucarile et al. (hereinafter Fucarile), US 6,766,305 B1.

As per the following claims, Fucarile discloses:

1. A method for software license management and online software license enforcement comprising the steps of:

- a) providing individual licenses for regulating the use of a software product (column 5, lines 37-41; figure 3, 301),
- b) controlling a transfer of licenses (column 5, lines 45-58; figure 3, 302),
- c) providing individualized copies of said software product for download (column 8, lines 1-4; figure 3, 309), and
- d) monitoring an execution of each individualized copy of said software product in agreement with the individual license terms (column 6, line 29-column 7, line 5; figure 3, 307, figure 4 and associated text).

2. A method for software license management and online software license enforcement according to claim 1, characterized in that said individualizing step comprises embedding information in said individualized copies of said software product (column 14, lines 50-57).

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3. A method for software license management and online software license enforcement according to claim 1 or 2, characterized in that said individualizing step generates a uniquely individualized copy of said software product for each download (figure 3, 300 Unique ID).
4. A method for software license management and online software license enforcement according to claim 1, characterized in that each subject joining the procedure of said software license management and online software license enforcement is subject to register prior to being granted access (column 5, lines 33-39, program or plug-in loaded).
5. A method for software license management and online software license enforcement comprising the steps of:
 - a) providing individual licenses for regulating the use of a software product (column 5, lines 37-41; figure 3, 301),
 - b) controlling a transfer of licenses (column 5, lines 45-58; figure 3, 302),
 - c) providing individualized copies of said software product for download (column 8, lines 1-4; figure 3, 309), and
 - d) monitoring an execution of each individualized copy of said software product in agreement with the individual license terms characterized in that said modifying is at least partly based on information extracted from at least a part of data of one or more initial and/or intermediate and/or final states of the creation process of said software product (column 6, line 29-column 7, line 5; figure 3, 307, figure 4 and associated text).

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6. A method of modifying one or more files of a software product, according to claim 5, characterized in that said modifying comprises embedding information in at least one of said files (column 14, lines 50-57).
7. A method of modifying one or more files of a software product according to claim 5 or 6, characterized in that said data comprise data of one or more object files generated during the creation process of said software product (column 6, lines 53-67).
8. A method of modifying one or more files of a software product according to claim 5, characterized in that said data comprise data of the debug information generated during the creation process of said software product (figure 10 and associated text).
9. A method of modifying one or more files of a software product according to one of the claims 5, characterized in that said data comprise data of the relocation information generated during the creation process of said software product (column 13, lines 3-10).
10. A method of modifying one or more files of a software product according to one of the claims 5, characterized in that said modifying is carried out on one or more executable files of said software product (column 14, lines 1-25).

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11. A method of modifying one or more files of a software product according to one of the claims 5, characterized in that said modifying comprises a modification of the arrangement of the subroutines within said software product (column 14, lines 11-21).

12. A method of modifying one or more files of a software product according to one of the claims 5, characterized in that said modifying comprises a modification of the arrangement of the variables within said software product (figure 3, 304-310).

13. A method of modifying one or more files of a software product according to one of the claims 5, characterized in that said modifying comprises inserting data and/or code between any two subroutines within said software product (column 14, lines 50-57).

14. A method of modifying one or more files of a software product according to one of the claims 5, characterized in that said modifying comprises inserting data and/or code between any two variables within said software product (column 14, lines 50-57).

15. A method of modifying one or more files of a software product according to one of the claims 5, characterized in that said modifying comprises inserting data and/or code into the code of one or more subroutines within said software product (column 14, 1-25).

16. A method of modifying one or more files of a software product according to one of the claims 5, characterized in that data and/or code for testing the integrity of one or more parts of

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one or more modified files is embedded within said software product (column 14, line 34-column 15, line 19).

17. A method of modifying one or more files of a software product according to one of the claims 5, characterized in that said modifying comprises at least embedding a part of a piece of verification software (figure 3, 305 verification phase).

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

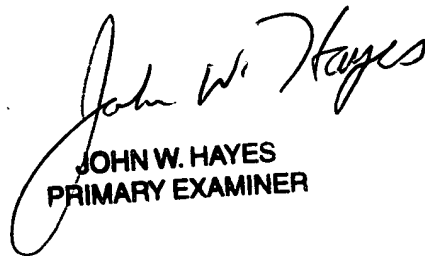
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley B. Bayat whose telephone number is 571-272-6704. The examiner can normally be reached on Tuesday-Friday 8am-6: 30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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JOHN W. HAYES
PRIMARY EXAMINER